

REMARKS

Claims 1, 3, 4, 7-12, 14, 15, 18-22, 33, 35, 36, 39-41, 43, and 44 are pending. Claims 1, 12, 33, 39, and 41 have been amended.

Claim 1 was amended to fix a minor antecedent basis issue; no new matter is believed to be added by way of this amendment.

Support for amendment of claims 12, 33, 39, and 41 can be found in the Specification as filed in at least paragraph [0091] and Figure 18. The amendments are substantially similar to amendments made to claim 1 in the previous response. No new matter is believed to be added by way of these amendments.

Claims 1, 3, 7-9, 12, 14, 18-20, 33, 35, 39-41, and 43 were rejected under 35 U.S.C. §103(a) as being unpatentable over US Pat. No. 6,093,102 to Bennett (Bennett '102) in view of Applicant's so-called Admitted Prior Art (Applicant's Specification, page 1, line 24, to page 2, line 8) (AAPA), US Pat. No. 6,261,178 to Bennett (Bennett '178), and U.S. Pat. No. 6,485,367 to Joshi (Joshi).

Claims 4, 15, 36, and 44 were rejected under 35 U.S.C. §103(a) as being unpatentable over Bennett '102 in view of AAPA, Bennett '178, U.S. Pat. No. 6,231,442 to Mayerhoff (Mayerhoff), and Joshi.

Claims 10, 11, 21, and 22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Bennett '102 in view of AAPA, Bennett '178, U.S. Pat. No. 6,001,016 to Walker et al. (Walker), and Joshi.

35 U.S.C. §103(a) Rejection of Claim 1

Claim 1 was rejected under 35 U.S.C. §103(a) as unpatentable over Bennett '102 in view of AAPA, Bennett '178, and Joshi.

Amended claim 1, for example, provides for a controller programmed to make an automated selection from a set of one or more unselected options after a person has selected one or more options. Claim 1 also provides for the controller being programmed to make an automated selection from the set of one or more unselected options according to the rules of a wagering game being played and according to a strategy to optimize the likelihood that the person will receive a value payout. Applicant maintains the arguments made during the previous response with regard to the failings of the cited prior art.

Applicant's prior response noted that the cited prior art failed to teach that the automated selection of one or more unselected options occurs after a person has selected one or more user-selectable options and from the set of one or more unselected options. The present Office Action

states that this is a “...mere re-ordering of know[n] steps...” and is “...prima facie obvious (see MPEP 2144.04.IV.C).” Applicant respectfully disagrees.

Applicant notes that the Office Action references a section of the MPEP that applies to process claims and that claim 1 is actually an apparatus claim. For the sake of discussion, however, Applicant’s response will use the language of the Office Action and refer to these claim elements as “steps”.

A rejection based on a “mere re-ordering of known steps” argument requires that the steps be “known”; i.e., the prior art must actually teach the steps that are merely re-ordered. In the present rejection, the steps in question, as stated by the Office Action, are the “player selection” step and the “automated selection” step. (Office Action, page 6, line 14). For the purposes of discussion only, Applicant will use these same labels to refer to these “steps”.

With regard to the language of claim 1, Applicant understands the “player selection” step to correspond to “...said controller being programmed to allow said person to select one or more options from a plurality of user-selectable options presented to said person, resulting in a set of one or more selected options and a set of one or more unselected options...” Applicant further understands the “automated selection” step to correspond to “...said controller being programmed to make an automated selection from said set of one or more unselected options in response to said request, after said person has selected one or more options, and according to the rules of said wagering game being played and according to a strategy to optimize the likelihood that said person will receive a value payout...”

The Office Action indicates that only the “player selection” step and the “automated selection” step are involved in the mere re-ordering of known method steps. (Office Action, page 6, lines 10-16). Since claim 1 expressly requires that the player selection step occur before the automated selection step, the “known method” that the Office Action refers to must involve the automated selection step occurring before the player selection step. There are several issues with the Office Action’s analysis of claim 1 and the cited prior art, which Applicant addresses below.

First, the cited prior art fails to teach an automated selection step corresponding to “...said controller being programmed to make an automated selection from said set of one or more unselected options in response to said request, after said person has selected one or more options, and according to the rules of said wagering game being played and according to a strategy to optimize the likelihood that said person will receive a value payout...”

As previously noted, the Office Action refers to clauses of claim 1 as reciting “player selection” and “automated selection” steps. The Office Action then refers to a non-equivalent set

of features described in AAPA by the same labels and states that AAPA teaches these steps but in a different order. (Office Action, page 6, lines 7-15).

While Applicant understands that paraphrasing or labeling lengthy clauses of a claim can aid in discussion of the claim, care must be taken to avoid applying the same labels to sections of the prior art that do not actually contain all of the elements recited in the paraphrased or labeled claim language. In this case, AAPA describes a Keno machine equipped with a controller that a player can direct to randomly select play numbers to play in the Keno game (referred to, apparently, as the equivalent of the “automated selection” step by the Office Action). (Specification as filed, page 1, line 27, to page 2, line 4). The player is given the option of changing the play numbers *after* the controller randomly selects the play numbers (referred to, apparently, as the equivalent of the “player selection” step by the Office Action). (Specification as filed, page 2, lines 6-10).

Notably, AAPA does *not* describe a situation in which the player makes selections of play numbers in the Keno game followed by the controller randomly selecting further play numbers *from the unselected play numbers*. Thus, AAPA cannot be said to teach all elements of the “automated selection” step of claim 1, and the “automated selection” step of claim 1 cannot therefore be said to be a “known step” in light of the cited prior art. Thus, claim 1 cannot be said to represent a mere re-ordering of *known steps*.

Secondly, even if AAPA did teach the automated selection step and player selection step as stated by the Office Action, a selection of any order of performing process steps would be *prima facie* obvious only *in the absence of new or unexpected results*. MPEP §2144.04.IV.C states:

...selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results...

Applicant respectfully submits that the gaming apparatus of claim 1 would produce new results, i.e., an operable apparatus, compared with an apparatus performing the automated selection step followed by the player selection step as put forth by the Office Action, i.e., an inoperable apparatus.

By way of explanation, if the automated selection step is performed first, there would be no set of unselected options resulting from the player selection step from which the automated selections could be made. Thus, an apparatus implementing the automated selection step before the player selection step, as suggested by the Office Action, would be inoperable. Applicant respectfully submits that an operable apparatus represents a “new or unexpected” result compared with an inoperable apparatus.

Furthermore, even if one were to assume that the steps as recited in Applicant's claim 1 were "known steps", there would still be a new result stemming from re-ordering the steps into the order defined by claim 1. As noted previously, there are two possible permutations of the "automated selection" and "player selection" steps.

The first, which is suggested by the Office Action, involves the player selection occurring after the automated selection. The second, which is defined by claim 1, involves the automated selection occurring after the player selection.

In the first permutation, the automated selection step would presumably select options according to a strategy to optimize the likelihood that a player will receive a value payout. After the automated selection step occurs, the player would then make their own selections. By doing so, the player compromises the optimization strategy employed during the automated selection step.

By contrast, the second permutation involves the automated selection step occurring after the player selection step. Thus, the selections made according to a strategy to optimize the likelihood of a value payout during the automated selection step are left unaltered and the strategy is preserved. The second permutation, corresponding to the step order defined in claim 1, results in a new result—an optimized selection—compared with the result of the first permutation, which is a compromised selection.

Perhaps recognizing that a new result occurs depending on the order of the steps, the Office Action provides a rationale for reversing the order of the steps purportedly from AAPA. The Office Action states:

It would have been obvious to one of ordinary skill in the art at the time of invention to have included a player selection of game elements prior to an automated selection of elements in order to allow participants to fill in their favorite or lucky selections and allow the gaming device to populate the rest of the matrix thereafter and therewith adding an element of convenience in the selection process through ensuring that the players favorite or lucky selection are included without enduring the burden of inspecting and adjusting automated selection to ensure the inclusion of favorite or lucky numbers.

Applicant respectfully submits that this rationale appears flawed. AAPA teaches automated selection of play numbers for Keno. The automated selection of Keno numbers is random—thus, there is no strategy employed in the automated selection of Keno numbers to optimize the likelihood of a value payout. Whether the automated selection of Keno numbers occurs before or after the player selection of Keno numbers is immaterial to the likelihood of winning a value payout in Keno. Thus, there is no benefit from a strategic standpoint to changing the order of the steps in AAPA.

Furthermore, if the player must make their selections before the automated selection, the player must affirmatively select *all* of their selections. If the player makes their selections after the automated selection, the player need only select the selections *not already selected* in the automated selection. The order of steps disclosed in AAPA actually represents a lesser burden on the player than the player selection/automated selection ordering proposed by the Office Action. Applicant therefore respectfully submits that it would not have been obvious to re-order the steps of AAPA even if the steps disclosed all of the features recited in the automated selection step of claim 1.

Applicant respectfully submits that the automated selection step of claim 1 is not a “known” step in view of the cited prior art. Additionally, Applicant respectfully submits that the player selection/automated selection step order of claim 1 provides new results compared with the automated selection/player selection order suggested by the Office Action. For at least these reasons, Applicant requests the withdrawal of the 35 U.S.C. §103(a) rejection of claim 1.

Amended independent claims 12, 33, 39, and 41 recite features similar to those discussed above with respect to claim 1 and would not have been obvious over the cited art for at least reasons similar to those given in support of claim 1. Applicant therefore respectfully requests the withdrawal of the 35 U.S.C. §103(a) rejection of claims 12, 33, 39, and 41.

The dependent claims include all of the features of the independent claims they depend from and, therefore, would not have been obvious for at least the reasons discussed with respect to the independent claims. Thus, it is respectfully requested that the rejections of these dependent claims under 35 U.S.C. § 103(a) be withdrawn.

CONCLUSION

For the above reasons, Applicant believes all claims now pending in this application are in condition for allowance. Applicant therefore respectfully requests that a timely Notice of Allowance be issued in this case. Should the Examiner believe a telephone conference would expedite prosecution of this Application, please contact the undersigned at the telephone number set forth below.

Applicant hereby petitions for any additional extension of time that may be required to maintain the pendency of this case, and any required fee for such extension or any further fee required in connection with the filing of this amendment is to be charged to Deposit Account No. 504480 (Order No. IGT1P530).

Respectfully submitted,
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